

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

71709 / 7114

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on April 25, 2008

Signature /Steven M. Freeland/

Typed or printed name Steven M. Freeland

Application Number

09/745,606

Filed

Dec 20, 2000

First Named Inventor

Nishikawa

Art Unit

2623

Examiner

SHANG, Annan Q.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the



applicant/inventor.

/Steven M. Freeland/

Signature



assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Steven M. Freeland

Typed or printed name



attorney or agent of record.

Registration number 42,555

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Telephone number



attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<p>Appln. No.: 09/745,606</p> <p>Applicants: Yuko S. Nishikawa et al.</p> <p>Filed: December 20, 2000</p> <p>Title: SYSTEM AND METHOD FOR PROVIDING CHANNEL SELECTION IN AN ELECTRONIC PROGRAMMING GUIDE</p> <p>Examiner: SHANG, Annan Q.</p> <p>Art Unit: 2623</p> <p>Confirm. No.: 1200</p> <p>Customer No.: 22242</p>	<p><u>Certificate of Transmission</u></p> <p>I hereby certify that this correspondence is being facsimile transmitted to the USPTO, transmitted via the Office electronic filing system, or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below:</p> <p><u>April 25, 2008</u> <u>/Steven M. Freeland/</u> Date Steven M. Freeland Registration No. 42,555 Attorney for Applicants</p>
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop: AF
Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action mailed January 25, 2008, please enter the following brief in support of the attached Pre-Appeal Request for Review. A Notice of Appeal is also submitted herewith.

Claims 1-11 and 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,141,003 to Chor et al. (hereinafter referred to as the Chor patent) in view of U.S. Patent No. 6,336,053 to Beatty (hereinafter referred to as the Beatty patent).

I. Clear Error: The Office Action fails to Address and Examine all of Applicants' claims.

Claim 21: Applicants respectfully submit that the pending office action fails to address and examine previously added claim 21. It is respectfully submitted that with regard to claim 21 the office action fails to present any grounds for rejection and further fails to mention claim 21 in the office action. MPEP §707.07(i) states that “[i]n every Office action, each pending claim should be mentioned by number, and its treatment or status given.” The office action fails to consider claim 21, provide grounds for rejecting claim 21 and further fails to provide any response with respect to claim 21. Therefore, Applicants respectfully submit that the office action is in error.

Moreover, Applicants respectfully submit that at least claim 21 is not obvious over the Chor patent in view of the Beatty patent. The Chor and Beatty patents fail to teach or suggest a second menu as claimed, and further fail to teach or suggest at least a menu with a graphical portion and instructions superimposed over the show displayed in the graphical portion. Therefore, the applied combination of the Chor and Beatty patents does not teach each limitation as recited in at least claim 21, and thus, a *prima facie* case of obviousness has not been established and the office action is in error.

II. Clear Error: No *prima facie* case of obviousness has been established because the applied combination does not teach or suggest all limitations as claimed.

Applicants respectfully submit that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art (see MPEP 2143.03). The MPEP further states “Distilling an invention down to the ‘gist’ or ‘thrust’ of an invention disregards the requirement of analyzing the subject matter ‘as a whole’” (MPEP 2141.02). The applied combination of the Chor and Beatty patents fails to teach or suggest all of the limitations of the pending claims. Thus, Applicants respectfully submit that there is a clear error in the rejection as a *prima facie* case of obviousness has not been established.

Claims 1 and 11: Both the Chor and Beatty patents fail to teach or suggest “displaying a remove icon in place of the add icon where the remove icon is selectable to remove the channel associated with the show currently being displayed from said memory when the

current channel is stored in said memory” as recited for example, in claim 1. The office action specifically admits that the Chor patent does not teach “a ‘remove’ icon” (see at least Office Action, pg. 4). Further the Beatty reference does not describe or suggest “a remove icon in place of the add icon,” and further does not teach “displaying a remove icon ... when the current channel is stored in said memory” as recited for example in claim 1.

The office action cites Figure 11 and col. 27, lines 15-30 of the Beatty patent in attempts to show a remove icon in place of an add icon. However, the Beatty patent and the cited portion do not describe or suggest replacing an add icon with a delete icon. Instead, the Beatty patent only describes multiple distinct displayed screens where one of the screens, a “machine login screen” of Figure 14 and a different “containers screen” of Figure 11. The “machine login screen” of Figure 14 has both an “ADD button” 1022 and a “Delete button” (see Beatty, FIG. 14, and col. 27, lns. 5-30), and the distinct and different “containers screen” of Figure 11 has an “ADD button” 1022 and a “RETIRE button” 1028. There is no suggestion in Beatty that the delete button is displayed in place of the add button. Still further, Beatty does not describe or suggest displaying the Delete button in place of the add button when the current channel is stored in said memory.

Additionally, the portion of Beatty cited by the office action, i.e., col. 27, lns. 21-24, describes the “machine login screen” of Figure 14, while Figure 11 also referenced by the office action is a distinct and different screen of a “containers screen 1000.” There is no relationship with respect to the buttons or content available through these the “machine login screen” and the “container screen” and Beatty does not teach or suggest replacing the “Delete” button of the “container screen” with a “Retire” button, or replacing the “Retire” button of the “machine login screen” with a “Delete” button. Instead, Beatty at col. 27, lines 21-24 references Figure 11 in describing the screen of Figure 14 only for the sake of simplifying the description of the screen of Figure 14. As such, the Beatty reference does not describe at least “a remove icon in place of an add icon ... when the current channel is stored in said memory” as claimed. Therefore, the applied combination does not teach each limitation as recited in claims 1 and 11.

Beatty does not describe replacing an Add button with a Delete button. To suggest that col. 27, lines 15-30 of the Beatty patent describes replacing an Add button within a user

interface with a Delete button takes the description out of context and ignores the subject matter of the Beatty patent as a whole. The Beatty patent does not describe replacing an Add button with a Delete button, and Beatty does not suggest replacing an Add button with a Delete button. Therefore, the applied combination does not teach each limitation as recited in at least claims 1 and 11, and thus, a *prima facie* case of obviousness has not been established and the office action is in error.

III. Clear Error: The Office Action again rejected claims without addressing the substance of Applicants arguments at least with respect to claims 18 and 19.

The MPEP specifically states, “Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it” (MPEP, §707.07(f)). Applicants respectfully submit that the office action fails to address arguments presented in the response to the previous office action mailed October 20, 2006, at least with respect to claims 18 and 19. As such, the office action is in error, and Applicants respectfully request that the rejections with respect to claims 18 and 19 be withdrawn.

More specifically with regard to at least claim 18, Applicants respectfully submit that there is no teaching or suggestion in Chor or Beatty at least to display a screen menu with a scrollable listing of channels and a graphical portion displaying shows corresponding to the channels during scrolling. Instead, Chor requires the user to click on the icon currently having focus in order to view the show corresponding to the channel stored in memory (Chor, col. 8, lines 39-67). The office action generally rejects claims 17-20; however, the portions of Chor cited in the office action do not describe a second menu having both the graphical portion and scrollable list with the graphical portion displaying a show corresponding to a channel in the list. (See also Response to Office Action Mailed October 20, 2006, pg. 11).

Moreover regarding at least claim 19, Applicants respectfully submit that the Chor patent fails to teach or describe at least the secondary menu including a description of the show corresponding to the channel in the list of channels stored in memory as recited by claim 19. The channel bars displaying the stored channels described by Chor are a set of linearly arranged actuatable icons associated with a particular stored channel and do not comprise a text portion

providing a program description for the show corresponding to a channel stored in memory (Chor, col. 2, lines 39-41 and 48-50). (See also Response to Office Action Mailed October 20, 2006, pg. 11-12). The Beatty patent also does not describe those elements identified above. Therefore, the combination of the Chor and Beatty patents does not teach or suggest all of the limitations of at least claims 18 and 19, and thus, a *prima facie* case of obviousness has not been established and the office action is in error.

CONCLUSION

Applicants respectfully submit that there is at least one clear error that would overcome the rejection of at least one claim; therefore, Applicants respectfully request that the Office Action be withdrawn.

Dated: April 25, 2008

Respectfully submitted,
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